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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,454	09/13/2001	Nilgun E. Turner	OCIRS-073	4316

7590 03/21/2003

Lerner David Littenberg
Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 07090

EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/21/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/936,454	TUMER ET AL.	
	Examin r	Art Unit	
	Cynthia Collins	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 17-21 and 28-29, drawn to a transgenic plant, including a transgenic plant of the *Solanaceous* family comprising at least one non-native nucleic acid encoding a wild-type *Arabidopsis* CGS, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid.

Group II, claim(s) 1-2, 4, 17-21 and 28-29, drawn to a transgenic plant, including a transgenic plant of the *Solanaceous* family comprising at least one non-native nucleic acid encoding a mutant, non-self regulating *Arabidopsis* CGS, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid.

Group III, claim(s) 1-2, 5-6, 17-21 and 28-29, drawn to a transgenic plant, including a transgenic plant of the *Solanaceous* family comprising at least one non-native nucleic acid encoding a potato CGS, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid.

Group IV, claim(s) 1-2, 5-6, 17-21 and 28-29, drawn to a transgenic plant, including a transgenic plant of the *Solanaceous* family comprising at least one non-native nucleic acid encoding a tomato CGS, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid.

Group V, claim(s) 1-2, 5-6, 17-21 and 28-29, drawn to a transgenic plant, including a transgenic plant of the *Solanaceous* family comprising at least one non-native nucleic acid encoding a tobacco CGS, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid.

Group VI, claim(s) 1-2, 5-6, 17-21 and 28-29, drawn to a transgenic plant, including a transgenic plant of the *Solanaceous* family comprising at least one non-native nucleic acid encoding an ice plant CGS, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid.

Group VII, claim(s) 1-2, 5-6, 17-21 and 28-29, drawn to a transgenic plant, including a transgenic plant of the *Solanaceous* family comprising at least one non-native nucleic acid encoding a maize CGS, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid.

Group VIII, claim(s) 1-2, 7, 17-21 and 28-29, drawn to a transgenic plant, including a transgenic plant of the *Solanaceous* family comprising at least one non-native nucleic acid encoding a bacterial CGS, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid.

Group IX, claim(s) 1, 8-9, 14-21 and 25-29 drawn to a transgenic plant, including a transgenic potato plant comprising at least one non-native nucleic acid comprising a

tuber-specific promoter operably linked to an anti-sense SAMS DNA, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid other than a nucleic acid that encodes a plant CGS.

Group X, claim(s) 1, 10, 14-21 and 25-29, drawn to a transgenic plant, including a transgenic plant of the *Solanaceous* family comprising at least one non-native nucleic acid comprising an anti-sense threonine synthase DNA, and a method of making a plant having increased free methionine levels by preparing a transgenic plant containing a non-native nucleic acid other than a nucleic acid that encodes a plant CGS.

Group XI, claim(s) 22-23, drawn to a processed product comprising a potato tuber.

Group XII, claim(s) 22 and 24, drawn to a processed product comprising a tomato fruit.

Group XIII, claim(s) 30-31, drawn to a processed product comprising a maize seed.

Group XIV, claim(s) 30 and 32, drawn to a processed product comprising a soybean seed.

Group XV, claim(s) 33-36, drawn to a chimeric nucleic acid comprising a promoter operably linked to a first DNA of interest and a second DNA encoding a CGS, a transformed plant cell, a composition of matter, and a method of selecting a plant cell transformed with a chimeric nucleic acid comprising a promoter operably linked to a first DNA of interest and a second DNA encoding a CGS.

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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The technical feature linking Groups I-XV appears to be a transgenic plant in which expression of a nonnative nucleic acid results in increased free methionine levels relative to native free methionine levels. However, Brinch-Pedersen et al. (Plant Molecular Biology, November 1996, Vol. 32, No. 4, pages 611-620) teach or suggest a transgenic plant in which expression of a nonnative nucleic acid results in increased free methionine levels relative to native free methionine levels. Therefore, the technical feature linking Groups I-XV does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Accordingly, Groups I-XV are not so linked by the same or corresponding special technical feature so as to form a single general inventive concept. Furthermore, the special technical feature of each of Groups I-X is the specific polynucleotide sequence of each Group, and sense overexpression versus antisense inhibition of expression. Additionally, the special technical feature of Group XI is a processed product comprising a potato tuber, the special technical feature of Group XII is a processed product comprising a tomato fruit, the special technical feature of Group XIII is a processed product comprising a maize seed, the special technical feature of Group XIV is a processed product comprising a soybean seed, and the special technical feature of Group XV is an in vitro method of selecting a cultured plant cell transformed with a chimeric nucleic acid comprising a promoter operably linked to a first DNA of interest and a second DNA encoding a CGS.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Remarks

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC
March 13, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180 1638

